

improper since it fails to establish that searching all the claims would be an undue burden to the Office and that the requirement is contrary to public policy.

At the outset, it is not clear if the new restriction requirement still requires that Applicants elect a compound B, and clarification on this issue is requested. If restriction is required with respect to compound B, Applicants elect Genapol 3938, with traverse. Applicants reserve the right to traverse this additional requirement in more detail once this issue has been clarified by the examiner.

The MPEP lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. MPEP §803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without a serious burden, . . . even though it includes claims to distinct or independent inventions.” *Id.*

Applicants urge that the restriction requirement does not meet the second of these criteria as the search for all of the groups overlaps. All of the compounds are classified in class 504, and in some cases there is an overlap of the subclasses. Further, it is urged that the compounds are so closely related that one would search all the different subclasses in order to conduct a complete search.

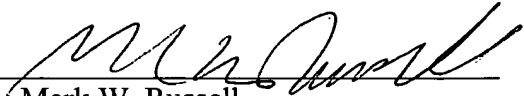
Further, it is respectfully urged that restricting the claims in the manner suggested in the Restriction Requirement constitutes an undue burden to Applicants as well as the public. The cost of prosecuting and maintaining so many patents is unreasonable in view of the fact that the eleven groups are so closely related. Further, the public is inconvenienced as they will not know whether or not Applicants will file a divisional application to the remaining subject matter.

Accordingly, the public will not know if they can practice the remaining invention without infringing future patent application.

Accordingly, modification or withdrawal of this Requirement is requested, and an early action on the merits is earnestly solicited.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP  
Attorneys for Applicants

By:   
Mark W. Russell  
Reg. No. 37,514  
(212) 588-0800